Attorney's Docket No. 1010315-000209

OIPE
OCT 14 2008

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )
Christian Almberg et al. ) Group Art Unit: 3761
Application No.: 10/684,585 ) Examiner: Jacqueline F Stephens
Filed: October 15, 2003 ) Appeal No.: ______________
For: BELTED ABSORBENT ARTICLE )

## APPEAL BRIEF

**Mail Stop APPEAL BRIEF - PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated August 12, 2008 finally rejecting claims 1, 8 and 12-21 which are reproduced as the Claims Appendix of this brief.

☐ A check covering the ☐ $ 270 ☐ $ 540 Government fee is filed herewith.

☒ Charge ☐ $ 270 ☒ $ 540 to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

10/15/2008 JADDO1 00000036 024800 10684585
02 FC:1402 540.00 DA

## I. Real Party in Interest

The present application is assigned to SCA Hygiene Products AB, which is the real party in interest.

## II. Related Appeals and Interferences

There are no prior or pending appeals, judicial proceedings or interferences known to the appellant which may be related to, directly affect or be directly affected by or having a bearing on the Board's decision in this appeal.

However, as set forth in greater detail below, the appeal which resulted in U.S. Patent No. 6,994,698 addressed issues quite similar to those presented in this appeal, and should therefore be of interest to the panel.

## III. Status of Claims

Claims 1 - 6 and 12 - 21 have been finally rejected as being unpatentable over U.S. H1674 (*Ames*). Claims 7 and 8 have been finally rejected over *Ames* in view of US 2003/0100878 (*Leak*). On September 18, 2008, SPE Zalukaeva sent, via facsimile, three pages of additional comments citing to additional sections of the applied references. The three pages are attached in the Evidence Appendix. Claims 9 - 11 have been indicated as containing allowable subject matter, but have been objected to.

## IV. Status of Amendments

No amendments have been filed after the final rejection.

## V. Summary Claimed Subject Matter

The following is a listing of the rejected claims wherein reference numbers and references to paragraphs from the published application (US 2004/0138640) have been inserted to "enable the Board to more quickly determine where the claimed subject matter is described in the application." These references are made to comply with 37 CFR 41.37(c)(1)(v). The references shall not be construed as limiting the claimed invention to the preferred disclosed embodiments.

1. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis (18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) is such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt, and said longitudinal axis (40, 42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained:

when $\alpha = 10^\circ$, $t \geq 720$ seconds;

when $\alpha = 20°$, $t \geq 330$ seconds;

when $\alpha = 25°$, $t \geq 240$ seconds;

when $\alpha = 30°$, $t \geq 180$ seconds; and

when $\alpha = 40°$, $t \geq 75$ seconds.

(release times: [0070]-[0074])

6. (Original) The article as claimed in claim 1, wherein each said belt half (12, 14) is attached to said absorbent structure (16) at said rear end region (32) between said topsheet (20) and said backsheet (22).

7. (Original) The article as claimed in claim 6, wherein each of said joints (50) between each said belt half (12, 14) and said rear end region (32) comprises two spaced substantially parallel lines of attachment (54) between each said belt half (12, 14) and said backsheet (22).

12. (Previously Presented) The article as claimed in claim 1, wherein each of said belt halves (12, 14) comprises a film/nonwoven laminate (paragraph [0063]).

19. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis(18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (20), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising exclusively nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30) and at least one fastening tab (38), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) is such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt and said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained:

when α = 10°, t ≥720 seconds;
when α = 20°, t ≥330 seconds;
when α = 25°, t ≥240 seconds;
when α = 30°, t ≥180 seconds; and
when α = 40°, t ≥75 seconds.
(release times: [0070]-[0074])

20. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis (18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising exclusively nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30) and at least one fastening tab(38), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16), wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) comprises means for joining whereby when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt and said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained (paragraphs [0067] through [0098]):

when α = 10°, t ≥ 800 seconds;
when α = 20°, t ≥ 370 seconds;
when α = 25°, t ≥ 260 seconds;
when α = 30°, t ≥ 220 seconds; and
when α = 40°, t ≥ 100 seconds.
(release times: [0094]-[0098])

21. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis(18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel(30), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) comprises means for joining such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis

(42) of the belt, said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), and the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained (paragraphs [0067] through [0098]):

when α = 10°, t ≥720 seconds;
when α = 20°, t ≥330 seconds;
when α = 25°, t ≥240 seconds;
when α = 30°, t ≥180 seconds; and
when α = 40°, t ≥75 seconds.
(release times: [0070]-[0074])

22. (New) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis (18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said belt halves (12, 14) is attached to the absorbent structure (16) between said topsheet (20) and said backsheet (22) with the respective joints (50) each comprising at least one region of bonding between each said belt half (12, 14) and said topsheet (20), and each of said joints (50) is spaced from the longitudinal edge (34) associated with the respective belt half (12, 14);

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) is such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt, and said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained:

when α = 10°, t ≥720 seconds;
when α = 20°, t ≥330 seconds;
when α = 25°, t ≥240 seconds;
when α = 30°, t ≥180 seconds; and
when α = 40°, t ≥75 seconds.
(release times: [0070]-[0074])

23. (New) The article as claimed in claim 1, wherein each of said belt halves (12, 14) is attached to the absorbent structure (16) between said topsheet (20) and said backsheet (22), and each of said joints (50) includes a region of attachment between the respective belt half (12, 14) and said backsheet (22) and a region of attachment between the respective belt half (12, 14) and said topsheet (20).

24. (New) The article as claimed in claim 23, wherein the region of attachment between the respective belt half (12, 14) and said backsheet (22) includes first and second spaced substantially parallel lines of attachment (54) between each respective belt half (12, 14) and said backsheet (22).

27. (New) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis (18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein the respective joints (50) each comprising means for counteracting the shear force which arises between each said belt half (12, 14) and the absorbent structure (16) when each belt half (12, 14) is subjected to a tension force at an angle α to the transverse axis such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt, and said longitudinal axis (42) of the belt creates an angle ($\alpha$) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained (paragraphs [0067] through [0098]):

when $\alpha = 10^\circ$, $t \geq 720$ seconds;
when $\alpha = 20^\circ$, $t \geq 330$ seconds;
when $\alpha = 25^\circ$, $t \geq 240$ seconds;
when $\alpha = 30^\circ$, $t \geq 180$ seconds; and
when $\alpha = 40^\circ$, $t \geq 75$ seconds.
(release times: [0070]-[0074])

## VI. Grounds of Rejection to be Reviewed on Appeal

(1) Whether claims 1 - 6 and 12 - 27 are unpatentable under 35 USC 102(e), (f), or (g) over U.S. H1674 (*Ames*).

(2) Whether claims 1 - 6 and 12 - 27 are unpatentable under 35 USC 103(a) over *Ames*.

(3) Whether claims 7 – 8 are unpatentable under 35 USC 103(a) over *Ames* in view of US 2003/0100878 (*Leak*).

## VII. Prior Art

**US H1674 *Ames*:**

Ames discloses a belted absorbent article comprising a topsheet 24, a backsheet 26 joined to the topsheet, an absorbent core 28 between the topsheet and the backsheet, and a pair of opposed belt halves 62,64. The Examiner acknowledges that Ames does not teach the claimed release times. See the first paragraph on page 6 of the Official Action dated January 24, 2008.

**US 2003/0100878 *Leak*:**

The Examiner relies upon Leak merely for its alleged teaching of an absorbent article where an elastomeric tab is attached to a liner with spaced apart parallel adhesive lines, as shown in Figure 9. See the first three lines of page 8 of the Official Action dated January 24, 2008.

## VIII. Argument

**Claim 1:**

The Examiner alleges that Ames discloses a belted absorbent article comprising a topsheet 24, a backsheet 26 joined to the topsheet, an absorbent core 28 between the topsheet and the backsheet, and a pair of opposed belt halves 62,64. The Examiner alleges that the belt halves of Ames "have elastic capabilities and can be subjected to a tension and provide a release time from that tension." However, the Examiner acknowledges that Ames does not teach the claimed release times. To overcome this deficiency, the Examiner makes the following argument:

> "The release times are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey* 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963) If the prior art structure is capable of performing the intended use, then it meets the claim limitations." Page 6 of the official Action dated January 24, 2008.

**The Examiner Ignores Structure in the Claims:**

The Examiner takes the position that the claims do not include any structure that distinguishes the claims over the prior art. The Examiner takes the position that the claim recitation concerning the strength, i.e., release times, of the joints does not define any structure. However, the Examiner's own analysis reflects the error in the conclusion. Specifically, while referring to factors that affect release times, the Examiner identifies, among other things, the materials used and the strength of the joint.[1] The Examiner alleges that "All of these factors presumable [sic] affect release times and all can be manipulated *without changing the structure of the article*".

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[1] The Examiner also refers to the "angle of the belt". As is clear from the specification, such language does not refer to the angle at which the belt is attached to the article, it refers to an angle that is created by a force applied to the belt. For example, the belt may be perpendicular to the transverse axis of the article (see paragraphs [0036] and [0040] of the as-filed application. However, the angle referred to in the claims is the angle of the force applied to the belt. See paragraph [0042] of the application. However, the present invention is not limited to the preferred disclosed embodiments.

(emphasis added) See the bottom half of page 2 of the Official Action dated January 24, 2008.

It is hard to imagine how one could "manipulate" the materials used and/or the strength of the joint without "changing the structure of the article". Such manipulations inherently change the structure of the article. Thus, Applicants submit that the Examiner has effectively conceded that the claim limitations define structure of the article.

The Board's attention is directed to § 2111.04 of the MPEP, wherein it states that when a whereby clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention. And, as explained in MPEP 2173.05(g):

> A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.... In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

**In re Venezia:**

The subject claim limitations are similar in concept to the structural limitations in *In re Venezia*. A copy of *Venezia* claim 31 is attached in the Evidence Appendix. The Examiner alleges that the present case is different from *Venezia*, alleging the cited case (*Venezia*) has substantial structural features. However, the claim at issue in *Venezia* included many phrases that are substantially similar to the phrases in the present case that the Examiner alleges to be an intended use, including, e.g., "adapted to be fitted", "capable of being assembled", "adapted to be affixed", and "may be slideably positioned".

Taking into account the italicized portions of the claim, the Court held that such language was structural, and not an intended use.

> "The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, *if assembled*...Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve."

The claims in the present application similarly recite structural limitations in the form of conditions that must be fulfilled by the claimed joints. For example, only joints that meet certain structural criteria will satisfy the release times. Accordingly, the test set forth in claim 1 is not dependent upon how the claimed article will be used, it is dependent on whether the claimed article has certain structural features, i.e., sufficient strength to meet the claim requirements. Applicants submit that the joints are limited by the requirements of the releasing clause since only certain joints will meet such requirements.

***In re Leak:***

Applicants also submit in the Evidence Appendix a prior Board decision (*In re Leak,* U.S. Patent No. 6,994,698) regarding claims that have the same issue as the present claims. The claims in *Leak* derived their patentability in large part upon a measured result, rather than from any specific recitation of the structure of the article that was used to meet the measured result. Applicants submit that the present application should be considered and examined with the same standards that were applied to its competitor's application which resulted in the *Leak* patent. Competitors need an even playing field. The Examiner has failed to address the issue, merely stating that she will not comment on the patentability of another application. However, Applicants are not requesting the Examiner's comments on the patentability of *Leak*, the Applicants merely want the Examiner to consider the fact that the type of claim limitations that the Examiner is ignoring in the present case were considered in full by the Board of Appeals in the *Leak* case.

***In re Casey:***

In *In re Casey*, cited by the Examiner, the claim at issue recited a function to be performed by the claimed machine. The Examiner in *In re Casey* refused to give patentable weight to the claimed functions. However, on appeal the Court held that the Board of Appeals ***properly considered the functional language***, and found that the machine disclosed in the applied reference was also capable of performing the recited functions. *Id.* At 237 – 38. ("The board considered that the structure provided by the reference possessed the capabilities requisite to meet the terms of the claims.") Thus, in *In re Casey,* the functional recitations *were considered.*

**The facts Do Not Support An Inherency Rejection**:

As a second position, the Examiner maintains that "when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.02)." However, according to MPEP, section 2112, IV, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." This is the principle discussed above with regard to *Leak et al.*

*Ames* does not disclose any specific structure for joining the belt flaps to the rear of the absorbent article. The entire disclosure related thereto, as set forth at col.

17, lines 51-53, is that if the belt flaps 62 and 64 are separate elements joined to the diaper 20, they can be joined "*by any means as known in the art.*" In order to rely on the theory of inherency, it must be shown that the recited conditions ***must*** be met in each and every instance. MPEP, section 2112, IV. Clearly, it must be recognized that ***all*** "means as known in the art" will not ***necessarily*** satisfy the requirements of the means for joining recited in claims 1, 19 and 20. Accordingly, the claimed joint cannot be inherent based on *Ames.*

**Unexpected Results:**

On page 4 of the Official Action dated January 24, 2008, the Examiner dismisses the Applicants' declaration concerning unexpected results.

In the Declaration Under Rule 1.132 of Mr. Christian Almberg, in paragraphs 3 and 6, Mr. Almberg explains that he and his colleague were able to establish that there ***surprisingly and unexpectedly*** existed a relationship for a given force between the angle at which the force was applied and the time it took for the belt half to become detached from the product. Thus, on the basis of these findings, by ensuring that the joints of a belted absorbent article display the claimed minimum average release times at the various values of the angle $\alpha$, the claimed absorbent article will be sufficiently reliable in use.

The Examiner refuses to consider the Applicants' unexpected results, alleging that the Applicants must submit specific comparative results between the present invention and the prior art. However, the Examiner has not correctly understood the unexpected results. Applicants submit that the unexpected result is the *relationship between the angle at which a force is applied and the time it took for the belt half to* *become detached*. Such data are clearly shown in detail in paragraphs [0056] and [0057] of the as-filed patent application.

Accordingly, the evidence of unexpected results must be considered.

**Nonobviousness:**

Contrary to the allegations of the Examiner, the present invention would not have been obvious to one having ordinary skill in the art. Specifically, the present invention is not simply a question of how strong or securely the belt halves are attached to the absorbent article. If that were the case, the joint between the belt halves and the absorbent article could simply be increased to a minimum level. Rather, the tendency for the belt halves to fail at increasing values of the angle α was not in the toolbox of knowledge of one skilled in the art. It is only with the benefit of this insight arrived at by the present inventors that one skilled in the art would even start to look for a solution to this problem. However, it is improper to use the unique findings of the inventors as a motivation for one skilled in the art to seek a solution to a problem that had not previously been identified.

According to the present invention, the joint between each belt half of the article and the absorbent structure should ensure that the article remains in the intended position on the wearer. This function places certain minimum requirements on the strength of the joint. As is explained in paragraph [0007] of the specification, the article must be capable of fulfilling these functions even when worn by wearers of greatly differing size and shape.

The present inventors have recognized that there is a tendency for existing belted absorbent articles to fail prematurely due to the joint between the belt halves and the absorbent structure, releasing either as the article is being put on or during use. With hindsight, one solution to such a problem might seem to be to make the joint between the belt halves and the absorbent structure stronger by, for example, using more adhesive or increasing the size of the bonding area. However, to keep production costs as low as possible and to keep the comfort of the product as high as possible, it is desirable to use as little bonding material as possible. To excessively increase the bonding area and/or the amount of adhesive in each product would lead to an unacceptable increase in the cost of such an article or decrease in the comfort of the article. Since adhesive generally restricts the breathability of an absorbent article, as well as tending to increase the stiffness of the regions of the article to which it is applied, it is desirable from a wearer comfort point of view to minimize the quantity of adhesive in an absorbent article.

The present inventors were therefore faced with providing a joint between belt halves in the absorbent structure of a belted absorbent article which they could be sure would be strong enough to be adequately reliable during use, but which would not incur undue expense during manufacture, nor unduly comprise wearer comfort. As explained in paragraph [0008] of the application, the inventors recognized that the failure of the joint between the belt halves and the absorbent structure was more prevalent at greater values of the angle $\alpha$, i.e., the angle between the longitudinal axis of the belt half and the transverse axis of the absorbent structure. They discovered that, in order for a belted absorbent article to function satisfactorily, while still keeping manufacturing costs as low as reasonably possible, the joint between each belt half and the absorbent structure should preferably meet certain minimum requirements depending upon the angle $\alpha$. The inventors discovered that if an article displays the minimum characteristics set forth in the claims, it will be adequately reliable in use. In other words, according to the present invention, a manufacturer can immediately ascertain whether his product will fulfill market expectations regarding reliability, and at the same time avoid "over engineering" the products.

It is the inventors' realization that the strength of the joint can be dependent upon the value of the angle $\alpha$, and that as a result, over engineering of the products can be avoided. It is the recognition of this relationship and its application to the present invention that is not taught or suggested by the prior art.

This situation is analogous to the numerous cases which hold that recognition of a problem must be considered in determining the obviousness of the solution. See, e.g., *In re Zurko*, 42 U.S.P.Q. 1476 (Fed. Cir. 1997) and *In re Hamilton*, 17 U.S.P.Q. 245 (C.C.P.A. 1933). Accordingly, the Examiner has failed to consider the fact that the applicants discovered the relationship between the angle $\alpha$ and the strength of the joint. *In view of the fact that no one in the prior art recognized this relationship, it cannot be said that the solution set forth in the claims is obvious.*

As a result of the inventors work, the claims define an article that is strong enough to function properly, and that can avoid being over-engineered. In view of the foregoing remarks, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection of claims 1 – 6 and 12 - 20.

In view of the foregoing, Applicants request that the rejection of claim 1 be reversed.

**Claims 6, 7, 12, 19, 20 – 24, and 27:**

The foregoing arguments with respect to claim 1 apply to each of the pending claims. In addition to the language set forth above with respect to claim 1, claims 6, 7, 12, 19, 20 – 24, and 27 contain additional language that was ignored by the Examiner. In the "paper" sent by the SPE on September 18, 2008, some of these elements were briefly addressed.

Even without considering the claimed release times, claims 6, 7, 12, 19, 20 – 24, and 27 contain significant structural features that have been literally ignored by the Examiner, in spite of many requests to consider such features.

**claim 6:** "attached...between said topsheet and said backsheet"

Claim 6 recites that each said belt half (12, 14) is attached to said absorbent structure (16) at said rear end region (32) between said topsheet (20) and said backsheet (22). In the "paper" sent by the SPE on September 18, 2008, it is alleged that the belt flaps can comprise the waist feature 34, and that the "waist feature is between the topsheet and backsheet". However, there is no support in *Ames* for such a conclusion. *Ames* does not state that the waist feature is between the topsheet and backsheet. Accordingly, claim 6 provides further structural details of the invention that have not been properly addressed by the Examiner.

Applicants submit that the features of claim 6 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 7:** "two spaced substantially parallel lines of attachment..."

Claim 7 recites that each of said joints (50) between each said belt half (12, 14) and said rear end region (32) comprises two spaced substantially parallel lines of attachment (54) between each said belt half (12, 14) and said backsheet (22). To meet this requirement, the Examiner refers to Figure 3 of Leak. However, Figure 3 of Leak has nothing to do with the attachment of a belt half to the backsheet in between the backsheet and the topsheet. Figure 3 of Leak discloses rows of fasteners for fastening a tab to an outside sheet of the article. Although Figure 9 of Leak discloses parallel rows 56 of adhesive, they are not used to attach a belt half between the backsheet and the topsheet. The rows 56 in Leak are used to secure a tab to an outside surface of the article.

Applicants submit that the features of claim 7 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 19:** belt halves are exclusively nonwoven

The Examiner has failed to address the fact that claim 19 requires that the belt halves are exclusively nonwoven. Applicants submit that the features of claim 19 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 20**: "*means* for joining..."

Claim 20 recites that each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) comprises ***means for joining*** such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt, said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), and minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained. The Examiner refers to column 17, lines 49 - 57, of Ames as a teaching of "means for joining belt halves". However, such "reference" fails to comply with the USPTO guidelines set forth in MPEP § 2181, which implements *In re Donaldson*. Specifically, the Examiner has ignored the structure in the specification that supports the joining function.

Applicants submit that the features of claim 20 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 21:** "*means* for joining..."

Claim 21 recites that each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) comprises ***means for joining*** such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt, said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), and minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained. The Examiner refers to column 17, lines 49 - 57, of Ames as a teaching of "means for joining belt halves". However, such "reference" fails to comply with the USPTO guidelines set forth in MPEP § 2181, which implements *In re Donaldson*. Specifically, the Examiner has ignored the structure in the specification that supports the joining function.

Applicants submit that the features of claim 21 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 22:** "one region of bonding between each said belt half and said topsheet, and each of said joints is spaced from the longitudinal edge..."

Claim 22 recites that each of said belt halves (12, 14) is attached to the absorbent structure (16) between said topsheet (20) and said backsheet (22) with the respective joints (50) ... and each of said joints (50) is spaced from the longitudinal edge (34) associated with the respective belt half.

The Examiner has stated "Even if the joints are at the longitudinal edge, they are still spaced somewhat from the longitudinal edge. One other interpretation is any point of the joint is spaced from the longitudinal edge as it is broadly claimed." See the "paper" faxed from the SPE. However, to the extent that this statement can be understood, it does not provide a "reasonable" interpretation of the claim language.

Applicants submit that the features of claim 22 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 23:** locations of regions of attachment

Claim 23 depends from claim 1 and states that each of said belt halves (12, 14) is attached to the absorbent structure (16) between said topsheet (20) and said backsheet (22), and each of said joints (50) includes a region of attachment between the respective belt half (12, 14) and said backsheet (22) and a region of attachment between the respective belt half (12, 14) and said topsheet (20). In other words, there is a region of attachment on each side of the belt half where the belt half is between the topsheet and the backsheet. In spite of the Examiner's additional comments in the "paper" faxed on September 18, 2008, this feature still has not been addressed.

Applicants submit that the features of claim 23 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 24:** "first and second spaced substantially parallel lines of attachment..."

Claim 24 recites that the region of attachment between the respective belt half (12, 14) and said backsheet (22) includes first and second spaced substantially parallel lines of attachment (54) between each respective belt half (12, 14) and said backsheet.

To meet this requirement, the Examiner refers to Figure 3 of Leak. However, Figure 3 of Leak has nothing to do with the attachment of a belt half to the backsheet in between the backsheet and the topsheet. Figure 3 of Leak discloses rows of fasteners for fastening a tab to an outside sheet of the article. Although Figure 9 of Leak discloses parallel rows 56 of adhesive, they are not used to attach a belt half between the backsheet and the topsheet. The rows 56 in Leak are used to secure a tab to an outside surface of the article.

Applicants submit that the features of claim 24 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

**claim 27:** "*means* for counteracting the shear force...".

Claim 27 recites that the respective joints (50) each comprise "means for counteracting the shear force which arises between each said belt half (12, 14) and the absorbent structure (16) when each belt half (12, 14) is subjected to a tension force at an angle α to the transverse axis...". Although not addressed in the final rejection, in the "paper" faxed on September 18, 2008, the Examiner stated that the means are not defined in the specification. However, § 2181 clearly states that support for a means plus function element may be implicit or inherent in the specification. It is only required that one skilled in the art will be able to determine what structure performs the recited function.

Applicants submit that one skilled in the art would have no trouble identifying the structure that counteracts the shear force. Accordingly, the Examiner has failed to examine this claim in accordance with the requirements of MPEP § 2181 and *In re Donaldson*.

Applicants submit that the features of claim 27 that have not been addressed by the Examiner, in combination with the rest of the claim, provide structure that renders the claimed product advantageous over the applied prior art, and that the rejection thereof should be reversed.

Accordingly, Applicants respectfully request that all rejections be reversed.

## IX. Claims Appendix

See attached Claims Appendix for a copy of the claims involved in the appeal.

## X. Evidence Appendix

See attached Evidence Appendix for copies of evidence relied upon by Appellant.

## XI. Related Proceedings Appendix

See attached Related Proceedings Appendix for copies of decisions identified in Section II, supra.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date October 14, 2008

By: William C Rowland
William C. Rowland
Registration No. 30888

P.O. Box 1404
Alexandria, VA 22313-1404
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## VIII. CLAIMS APPENDIX

**The Appealed Claims**

1. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis (18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) is such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt, and said longitudinal axis (40, 42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained:

when α = 10°, t ≥720 seconds;
when α = 20°, t ≥330 seconds;
when α = 25°, t ≥240 seconds;
when α = 30°, t ≥180 seconds; and
when α = 40°, t ≥75 seconds.
(release times: [0070]-[0074])

6. (Original) The article as claimed in claim 1, wherein each said belt half (12, 14) is attached to said absorbent structure (16) at said rear end region (32) between said topsheet (20) and said backsheet (22).

7. (Original) The article as claimed in claim 6, wherein each of said joints (50) between each said belt half (12, 14) and said rear end region (32) comprises two spaced substantially parallel lines of attachment (54) between each said belt half (12, 14) and said backsheet (22).

12. (Previously Presented) The article as claimed in claim 1, wherein each of said belt halves (12, 14) comprises a film/nonwoven laminate (paragraph [0063]).

19. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis(18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (20), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising exclusively nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30) and at least one fastening tab (38), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) is such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt and said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained:

when α = 10°, t $\geq$720 seconds;
when α = 20°, t $\geq$330 seconds;
when α = 25°, t $\geq$240 seconds;
when α = 30°, t $\geq$180 seconds; and

when α = 40°, t ≥75 seconds.

(release times: [0070]-[0074])

20. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis (18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising exclusively nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel (30) and at least one fastening tab(38), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) comprises means for joining whereby when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt and said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained (paragraphs [0067] through [0098]):

when α = 10°, t ≥ 800 seconds;

when α = 20°, t ≥ 370 seconds;

when α = 25°, t ≥ 260 seconds;

when α = 30°, t ≥ 220 seconds; and

when α = 40°, t ≥ 100 seconds.

(release times: [0094]-[0098])

21. (Previously Presented) A belted absorbent article (10) comprising:

an absorbent structure (16) extending about a first longitudinal axis(18), said absorbent structure (16) including a topsheet (20), a backsheet (22) and an absorbent batt (24) disposed between said topsheet (20) and said backsheet (22), said absorbent structure (16) having a transverse axis (T) dividing the absorbent structure (16) into a front panel (26) terminating in a front end region (28) and a rear panel (30) terminating in a rear end region (32), said absorbent structure (16) being delimited by opposed longitudinal edges (34) and opposed transverse edges (36), and

a pair of opposed belt halves (12, 14) comprising nonwoven material attached to said absorbent structure (16) at said rear end region (32) of said rear panel(30), each of said belt halves (12, 14) being attached by a respective joint (50, and paragraphs [0067] through [0098]), each belt half (12, 14) extending about a longitudinal axis (40, 42) of the belt such that each belt half (12, 14) extends outwardly from a respective longitudinal edge (34) of the absorbent structure (16),

wherein each of said joints (50) between each said belt half (12, 14) and said absorbent structure (16) comprises means for joining such that when each said belt half (12, 14) is subjected to a tension force of 35 N acting along said longitudinal axis (42) of the belt, said longitudinal axis (42) of the belt creates an angle (α) to said transverse axis of said absorbent structure (16), and the following minimum average release times (t) of each said belt half (12, 14) from said absorbent structure (16) are attained (paragraphs [0067] through [0098]):

when $\alpha = 10^\circ$, $t \geq 720$ seconds;
when $\alpha = 20^\circ$, $t \geq 330$ seconds;
when $\alpha = 25^\circ$, $t \geq 240$ seconds;
when $\alpha = 30^\circ$, $t \geq 180$ seconds; and
when $\alpha = 40^\circ$, $t \geq 75$ seconds.
(release times: [0070]-[0074])

# IX. EVIDENCE APPENDIX

1. 3 page facsimile from Tatyana Zalukaeva, dated September 18, 2008.
2. Claim 31 from In re Venezia
3. Board of Appeals decision from In re Leak

# X. RELATED PROCEEDINGS APPENDIX

None

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[phone]
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[Web address]

**USPTO**

# Fax

20315-209

| | | | |
|---|---|---|---|
| **To:** | Mr. William Rowland, esq. | **From:** | Tatyana Zalukaeva, PhD, SPE AU 3761 |
| **Fax:** | (703) 836-2021 | **Pages:** | 3, including this one |
| **Phone:** | (7703) 836-6620 | **Date:** | 09/18/2008 |
| **Re:** | 10/684,585 | **cc:** | |

☐ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

- **Comments:**

Dear Mr. Rowland,

As you requested I have reviewed the prosecution of this Application and discussed it with another senior examiner. Although, as I mentioned to you before, the PREAPPEAL review DOES NOT respond to Applicant's arguments but solely decides, if the case is ready to go for appeal, however, I am attaching brief statement showing the specific places in the references where the limitations of the claims are disclosed or fairly suggested.

I believe it would be better to respond this way instead of discussing it over the phone. I also think that the best way to resolve the disagreement on the claim interpretation and applicability of the reference(s) is by sending it to the Board.

If I can be of further assistance, please, do not hesitate to contact me. My schedule is extremely busy, however, I will definitely find the time to respond.

Sincerely

RECEIVED
SEP 18 2008
Buchanan Ingersoll & Rooney P

In the pre-appeal request filed 6/24/08, Applicant suggested several structural features that allegedly have been ignored by the Examiner. The following represents passages in Ames H1674 and Leak 2003/0100878 where the structural features can be found:

- Claim 6, :attached... between said topsheet and said backsheet" - found in Ames col. 17, lines 46-51 where Ames teaches the belt flaps 62, 64 can comprise an extension of the topsheet 24, backsheet 36 or both or the waist feature 34. The waist feature is between the topsheet and backsheet.
- Claim 7:"two spaced substantially parallel lines of attachment..." - found in Leak Figure 3.
- Claim 11:"each of said joint between each said belt half and said rear end region further comprises at least one region of bonding between each said belt half and said topsheet"- indicated in office action as allowable subject matter, why is Applicant arguing this point?
- Claim 12: "a film/nonwoven laminate" - found in Ames col. 17, lines 60-64; col. 18, lines 10-21 and in Buell 5151092, which is incorporated by reference
- Claims 20 and 21: "means for joining" - Ames col. 17, lines 49-57 teaches means for joining belt halves.
- Claim 22:"one region of bonding between each said belt half and said topsheet, and each of said joints is spaced from the longitudinal edge..." - Ames as discussed above teaches bonding of separate belt halves. Even

if the joints are at the longitudinal edge, they are still spaced somewhat from the longitudinal edge. One other interpretation is any point of the joint is spaced from the longitudinal edge as broadly as it is claimed.

- Claim 23:" locations of regions of attachment" - what is actually claimed is the belt halves are attached to the absorbent structure between the topsheet and backsheet (addressed above in claim 6); and each joint has a region of attachment between the backsheet and topsheet. If it is attached between the topsheet and backsheet it necessarily has a region of attachment.
- Claim 24:"first and second spaced substantially parallel lines of attachment this should have been rejected under Ames/Leak as in claim 7 above
- Claim 27:"means for counteracting shear force" - firstly means are not defined anywhere in the specification. We agreed in the panel review that any means can counteract the shear force, simply pulling on the diaper is a means to counteract shear force.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

MAILED

APR 24 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte A. TODD LEAK, APIROMRAJ S. ROSLANSKY,
PAUL T. VAN GOMPEL, GEORGIA L. ZEHNER,
EDWARD H. RUSCHER, and YUNG HSIANG HUANG

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Appeal No. 2000-0921
Application No. 08/366,090

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ON BRIEF

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Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-54, all the claims pending in the application.

Appellants' invention pertains to a mechanical fastener tab suitable for use on a disposable absorbent product (claims 1-11), wherein the fastening tab comprises a substrate and a first mechanical fastener component[1] joined to the substrate, with the fastening tab having a Gurley stiffness value[2] of less than about 1000 milligrams in the area of the fastening tab that includes the first mechanical fastener component. Appellants' invention also pertains to a disposable product (claims 12-33 and 54) and to a disposable absorbent product (claims 34-53) comprising a mechanical fastening tab as described above. According to appellants, mechanical fastening tabs in accordance with the invention have improved flexibility. A further understanding of the claimed invention can be derived from a reading of exemplary claim 1, which appears in the appendix to appellants' brief.

The references applied in the final rejection are:

| | | |
|---|---|---|
| Flug et al. (Flug) | 5,401,275 | Mar. 28, 1995<br>(filed Sept. 11, 1991) |
| Roessler et al. (Roessler) | 5,176,670 | Jan. 5, 1993 |

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[1] As stated on page 6 of appellants' specification, "a first mechanical fastener component is intended to refer to a material which is adapted to mechanically interlock with a second material. . . . In the illustrated embodiment, the first mechanical fastener component is the hook portion of a hook-and-loop fastener."

[2] Reference is made to pages 17-18 of appellants' specification for an explanation of a suitable technique for determining Gurley stiffness values.

Claims 1-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roessler in view of Flug. The examiner states (final rejection, page 2):

> Roessler teaches all aspect[s] of the claimed invention except for the specific Gurley stiffness values and substrate overlay of 2%-98%.[3] The Roessler article comprises similar materials as recited in applicants' invention, therefore the Gurley stiffness value is considered to be the same. The Gurley stiffness values recited in applicants' specification, even though performed in a standard testing machine, are considered useless for comparison purposes to the prior art. The Gurley stiffness values can vary depending to sample size and other factors. Even if Roessler stated a Gurley stiffness value, there would be no way to correlate a Roessler value with the claimed values due to different testing procedures.

The examiner further considers (final rejection, page 3) that substrate overlayment of from about 2% to about 98%, as called for in claims 8 and 20, is taught by Flug, and that it would have been obvious in view of this teaching to provide a similar overlayment arrangement in Roessler. The examiner contends (final rejection, page 3) that the rejection is proper because "[a]pplicants have not sufficiently demonstrated that the fastening tab of Roessler will not meet the test value of applicants' invention when tested in accordance to applicants' test method."

---

[3] The requirement that the substrate overlays from about 2 to about 98 percent of the planar surface of the first mechanical fastener component is found only in dependent claims 8 and 20.

*Discussion*

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner. *In re Piasecki,* 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In making a rejection on the ground that claimed subject matter would inherently be present in the apparatus or process described by a reference, the examiner bears the initial burden of making out a *prima facie* case, as by providing a basis in fact and/or technical reasoning which reasonably supports the position that what is allegedly inherent would necessarily flow from the teachings of the prior art. *See Ex parte Levy,* 17 USPQ2d 1461, 1464 (BPAI 1990) and the cases cited therein. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to a patent. *In re Oetiker,* 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1990).

The main issue in this case is whether Roessler discloses a fastener tab comprising a substrate and a mechanical fastener component wherein the tab has a Gurley stiffness value of less than about 1000 milligrams in the area of the tab that includes the mechanical fastener component. Because we do not agree with the examiner that the claimed invention necessarily flows from the disclosure of Roessler, we will not sustain the examiner's rejection.

The Roessler reference cited by the examiner against the appealed claims discloses, in pertinent part, a mechanical fastener tab 30 of the hook-and-loop type that is suitable for use on a disposable absorbent product. Beginning at column 6, line 29, and continuing to column 9, line 2, Roessler goes into considerable detail concerning the nature of the hook material and the loop material components of the mechanical fastener; however, it is not disputed that Roessler makes no mention whatsoever of the Gurley stiffness value of any of these fastener tab components. Nevertheless, the examiner takes the position that "[[t]he Roessler article comprises similar materials as recited in applicants' invention, therefore the Gurley stiffness value is considered to be the same [as that recited in the claims]" (final rejection, page 2). We surmise from this that the examiner considers the teachings of Roessler at, for example, column 6, line 29, through column 7, line 13, to be of such kind that a fastener tab having the claimed Gurley stiffness value would necessarily flow from making a fastener tab in accordance with these teachings.

In our view, the examiner has provided no basis in fact and/or technical reasoning which reasonably supports the above stated theory of inherency. More particularly, we find appellants' reasoning on pages 3-4 of the brief, which the examiner has not even attempted to refute, as to why the allegedly inherent Gurley stiffness value does *not* necessarily flow from Roessler's teachings to be persuasive. In brief, appellants argue that while the hook material described by Roessler appears to be like the hook material described on page 18 of appellants' specification in connection with example 1, this alone is not enough to establish that the area of the fastener tab in question[4] necessarily has a Gurley stiffness value within the claimed range. In that appellants' specification clearly points out[5] that the Gurley stiffness value at the claimed area is influenced by the physical properties of both the hook material *and* the substrate, appellants' argument is well taken. In addition, and as aptly pointed out by appellants on page 4 of the brief, fastener tabs made using the hook material described on page 18 of appellants' specification, which material is akin to that disclosed in Roessler, may or may not fall within the claimed Gurley stiffness value depending on the characteristics of the substrate. In light of this well reasoned argument, the examiner's unvarnished position to the effect that the claimed subject matter would necessarily result from using Roessler's hook material simply because the hook material of the reference is similar to that used by appellants in making the claimed invention cannot be sustained.

---

[4] That is, the area of the fastening tab that includes both the hook material and the substrate.

[5] See, for example, page 7, line 18, through page 8, line 15, and page 9, lines 6-15, of appellants' specification.

We are likewise in agreement with appellants that there is no factual basis for the examiner's contention (final rejection, page 2; answer, pages 3-4) that Gurley stiffness values can vary from sample to sample, such that even if Roessler stated a Gurley stiffness value, there would be no way to correlate a Roessler value with the claimed values. The examiner's contention (final rejection, page 3; answer, page 4) that the burden is on appellants to prove that the fastening tabs of Roessler will not have a Gurley stiffness value within the claimed range is simply wrong. *See In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444.

We have also considered whether Roessler would have rendered obvious a fastener tab having a Gurley stiffness value of less than about 1000 milligrams in the area of the fastening tab that includes the first mechanical fastener component, but find nothing in Roessler that would have suggested the claimed subject matter. Further, the examiner does not contend, and it is not apparent to us, that Flug makes up for the deficiencies of Roessler in this respect.

In view of the foregoing, the examiner's rejection of claims 1-54 as being unpatentable over Roessler in view of Flug cannot be sustained.

The decision of the examiner is therefore reversed.

*REVERSED*

IRWIN CHARLES COHEN )
Administrative Patent Judge )
)
)
Lawrence J. Staab )
LAWRENCE J. STAAB ) BOARD OF PATENT
Administrative Patent Judge ) APPEALS
) AND
) INTERFERENCES
John McQuade )
JOHN P. McQUADE )
Administrative Patent Judge )

LJS/lp

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## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 15

Application Number: 08/366,090
Filing Date: December 28, 1994
Appellant(s): Ruscher et al.

Thomas J. Mielke
For Appellant

## EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 22, 1997.

KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENAH, WI 54956

EXHIBIT 1

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulting jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cable and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location.*

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulting jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cable and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location*.